

Appl. No. 09/360,068
Amdt. dated September 15, 2004
Reply to Office Action of March 15, 2004

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REMARKS

This Response is being filed in response to the Office Action dated March 15, 2004. Enclosed separately herewith is a Request for Extension of Time to and including September 15, 2004. Also please make note of the Revocation of Power of Attorney and Appointment of New Power of Attorney previously filed by this office. It is requested that the Examiner make note of the new correspondence address for any subsequent communications regarding the above-identified patent application.

35 U.S.C. §102

The Examiner rejected claims 1, 2, 18, 29, 30 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,101,477 issued to Hohle et al.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See, W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ at 313. Anticipation requires the presence and a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. *See, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

Claim 1 has been amended above to include the step of demodulating the outgoing secure radio frequency signal without deciphering the outgoing secure data signal. Claims 2 and 4-16 depend from claim 1 and, therefore, the 35 U.S.C. §102(e) rejection should be withdrawn since Hohle et al. does not disclose a method of establishing a secure communication link between a smart card and a central computer system through a communication network as presently claimed in claims 1, 2, and 4-16.

The Examiner rejected claim 18 as allegedly being anticipated by Hohle et al. The Examiner stated that Hohle discloses a system where data is exchanged with a smart card through radio frequency communication. The Examiner also states the data is exchanged with a central computer and the issuer through a network. The Examiner also states that the security function performed on the data is as discussed in reference to claim 2.

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Hohle discloses methods and apparatus for a smart card system which securely integrate travel related applications. Hohle also discusses that it will be appreciated that contactless cards may also be utilized to practice the Hohle invention. Hohle goes on to state that non-contact communication methods may be employed using techniques as capacitive coupling and the like. Hohle goes on to state that capacitive coupling involves incorporating capacitive plates into the card body such that data transfer with a card reader is provided through symmetric pairs of coupled surfaces, wherein the capacitance values are typically in a particular range. See col. 3, lines 30-51.

In contrast, claim 18 is directed to a method of establishing a secure communication link between a smart card and a central computer system remotely located from a smart card, the method comprising the steps of: exchanging secure data through a radio frequency communications channel with the smart card, exchanging the secure data through a communication network with a central computer system, and performing a security function on the data at the central computer system. It is respectfully submitted that Hohle et al. does not provide a single prior art reference of each element of the claim under consideration as required under 35 U.S.C. §102. Further, Hohle does not provide a single prior art reference of each and every element of the claimed invention, *arranged as in the claim*, as further required under 35 U.S.C. §102. More specifically, the Examiner states that "the card then produces a MAC based on the received message and [the card] compares them and the two MACs will not match if the message or the wrong key has been used." In contrast, in claim 18, the step of performing a security function on the data is at the central computer system, as presently claimed. Therefore, it is respectfully requested that the rejection of claim 18 be withdrawn since Hohle et al. is not a suitable single prior art reference as required under 35 U.S.C. §102.

The Examiner also rejected claim 29 as allegedly being anticipated by Hohle et al. Claim 29 in the present application is directed to a smart card communication device for interfacing within a smart card communication system having a local processor coupled to a remotely located central computer system through a communication network, the smart card communication device comprising, a radio frequency transceiver adapted to exchange secure data with a smart card through a radio frequency communication channel, a data communication

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interface adapted to exchange the secure data with the processor through a baseband data communication channel without deciphering the secure data.

Hohle does not disclose a smart card communication device as presently claimed in claim 29. More specifically, Hohle does not provide a smart card communication device that includes a radio frequency transceiver adapted to exchange secure data with a smart card through a radio frequency communication channel and with a data communication interface adapted to exchange the secure data with a processor through a base and data communication channel without deciphering the secure data. Therefore, Hohle et al. is not a single prior art reference that discloses each element of the claim under consideration and is not a single prior art reference that discloses each and every element of the claimed invention arranged as in the claim. Therefore, it is respectfully requested that the 35 U.S.C. §102(e) rejection be withdrawn from claim 29. Claim 30 depends from claim 29 and therefore the rejection directed to claim 30 should be withdrawn as well.

35 U.S.C. §103

The Examiner rejected claims 3-17 and 31-34 as allegedly being unpatentable over Hohle in view of U.S. Patent No. 5,295,188 issued to Wilson et al.. The Examiner states that Hohle does not disclose a system where the outgoing secure signal is not deciphered after demodulation. The Examiner alleges, however, that Wilson discloses a system for public key encryption and decryption where data is encrypted by a smart card and decrypted at the central location.

There Must Be a Basis in the Art for Combining or Modifying the References

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *see, also*, MPEP §2143.01.

Hohle discloses methods and apparatus for a smart card system to integrate important travel related applications. See, Abstract. Further, Hohle is directed to updating data related to a card holder's travel information in the context of a distributed transaction system.

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See, col. 1, lines 8-11. Further, in Hohle, the problem being addressed is that, as stated in Hohle, smart card efforts are fragmented and the resulting benefit to consumers - particularly consumers who travel, has been quite minimal. See, col. 2, lines 8-11. In addition, Hohle addresses the issue of smart cards being incompatible. See, col. 2, lines 11-18. Further, Hohle is directed to providing a smart card system that securely and conveniently integrates important travel related applications overcoming the limitations of the prior art, in particular, in travel context such as airline, hotel, rental car, and payment related applications including specific applications with partnering organizations. See, col. 2, lines 22-34.

In contrast, Wilson et al. is directed to systems for encryption and decryption of digital data for achieving digital signatures for use in source message authentication processes and in smart card devices. See, col. 1, lines 21-26. The problems being solved in Wilson et al. are directed to operations that are slow and costly as well as the limitation in key size and security. In addition, block crypton schemes had been private key systems requiring a secure transmission channel for distribution of the private keys. These systems were generally incapable of producing digital signatures and source message authentication. See, col. 1, lines 41-49.

Therefore, the disclosure in Hohle et al. is directed to integrating important travel related applications and the disclosure in Wilson et al. is directed to block encryption and decryption of data for providing systems for achieving digital signatures for use in source message authentication processes and in devices such as smart card devices.

In stark contrast, claims 3-17 are directed to the method of establishing a secure communication link between the smart card and a central computer system through a communication network including the steps of demodulating an outgoing secure radio frequency signal transmitted from the smart card to produce an outgoing secure data signal, wherein the demodulating of the outgoing secure radio frequency signal is without deciphering the outgoing secure data signal, formatting the outgoing secure data signal in accordance with a communication network protocol to produce an outgoing formatted secure signal, and, transmitting the outgoing formatted secure signal to the central computer system.

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Applicant respectfully traverses the Examiner's rejection of claims 3-17 under 35 U.S.C. §103(a) as being unpatentable over Hohle in view of Wilson et al. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination of the prior art. *See, ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). There simply is not any teaching or suggestion or incentive to support the combination of Hohle with Wilson. Hohle is directed to integrating important travel related applications and Wilson is directed to providing sources for achieving digital signatures.

Therefore, it is respectfully submitted that there is no motivation, suggestion, or teaching to combine Hohle with Wilson to support the combination of those references to render claims 3-17 obvious under 35 U.S.C. §103(a). There simply would be no desirability to combine Hohle with Wilson.

The arguments outlined above are repeated herein regarding the Examiner's rejection of claims 31-34 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hohle in view of Wilson.

Therefore, it is respectfully submitted that there is no motivation, suggestion or teaching to combine Hohle with Wilson to support the combination of those references to render claims 31-34 obvious under 35 U.S.C. §103(a).

An Obviousness Rejection Requires a Reasonable Expectation of Success

For the Examiner to establish prima facie obviousness, there must be a reasonable expectation of success. As stated above, the Federal Circuit requires that some reason or suggestion must be found in the prior art or other evidence of record that would have led one of ordinary skill in the art to produce the claimed invention in order to properly establish a prima facie case of obviousness. In *In re Clinton*, 527 F.2d 1226 (CCPA 1976), the Court first looked at the references to determine whether "the references by themselves...suggest doing what appellants have done." The Court next considered whether a person of ordinary skill in the art would have had a sufficient basis for the required expectation of success. Thus, the Court held that obviousness does not require absolute predictability but a reasonable expectation of success

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is *necessary*. Accordingly, when going from the prior art to the claimed invention, one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led that person skilled in the art to do. Therefore, an "obvious to try" is an improper basis for a 35 U.S.C. §103 rejection when there is no suggestion or expressed expectation of success in the prior art that would have led one to perform an experimentation in the first place.

In the present case, as stated above, based on the different areas of technology and attempts to solve different problems relating to the Hohle reference versus the Wilson reference, and further yet that the combined elements that the Examiner suggests may render the resulting system inoperable, there is no suggestion or express expectation of success in the prior art that would have led one to perform the experimentation of combining Hohle with Wilson in the first place. Therefore, *inter alia*, the Examiner should withdraw the 35 U.S.C. §103 rejections under 3-17 and 31-34 as stated in the Office Action.

The Examiner also rejects claims 21-25 as allegedly being unpatentable under 35 U.S.C. §103(a) over Hohle in view of U.S. Patent No. 6,226,744 issued to Murphy et al. Murphy et al. disclose method and apparatus for authenticating a user over a network without having to install hardware or software on the client. See, col. 3, lines 23-36.

In contrast, claim 21 is directed to a method of establishing a secure communication link between a smart card and a central computer system remotely located from the smart card, the method comprising the steps of: downloading communication link interface software to a processor from a remote computer system, exchanging secure data between the smart card and a smart card communication device through a radio frequency communication channel, and, exchanging the secure data between the smart card communication device and the central computer system through the processor running the downloaded communication link interface software, wherein the processor is coupled to the central computer system through a communication network. As required in claim 21, a communication link interface software is downloaded to a processor from a remote computer system. Therefore, Murphy teaches away from the invention as presently claimed. Further, for the reasons outlined above, there is no teaching or suggestion to combine the references. Murphy is directed to reducing bottlenecks in

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terms of speed and convenience and utilizing a method and apparatus for authenticating a user over a network without having to install hardware or software on the client. Hohle, as explained above, is directed to integrating important travel related applications. Therefore, there is no suggestion, teaching or incentive to support the combination of the prior art references as cited by the Examiner.

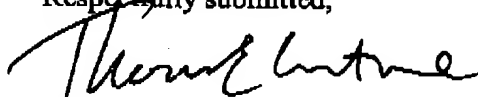
Therefore, it is respectfully submitted that the Examiner withdraw the 35 U.S.C. §103(a) rejection directed to claims 21-25.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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